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| PRE-APPEAL BRIEF REQUEST FOR REVIEW | | Docket Number (Optional) ET 98-41 D2 | | | | | | | |
| I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on <u>June 26, 2006</u> Signature _____ Typed or printed name <u>Thomas F. Marsteller, Jr.</u> | | <table border="1" style="width: 100%; border-collapse: collapse;"> <tr> <td style="padding: 5px;">Application Number 10/765,538</td> <td style="padding: 5px;">Filed January 27, 2004</td> </tr> <tr> <td colspan="2" style="padding: 5px;">First Named Inventor Iosue, Michael J.</td> </tr> <tr> <td style="padding: 5px;">Art Unit 2879</td> <td style="padding: 5px;">Examiner Dalei Dong</td> </tr> </table> | | Application Number 10/765,538 | Filed January 27, 2004 | First Named Inventor Iosue, Michael J. | | Art Unit 2879 | Examiner Dalei Dong |
| Application Number 10/765,538 | Filed January 27, 2004 | | | | | | | | |
| First Named Inventor Iosue, Michael J. | | | | | | | | | |
| Art Unit 2879 | Examiner Dalei Dong | | | | | | | | |
| <p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <div style="display: flex; justify-content: space-between; align-items: flex-start;"> <div style="width: 45%;"> <p><input type="checkbox"/> applicant/inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>29,672</u></p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____</p> </div> <div style="width: 50%; text-align: center;">  _____ Signature Thomas F. Marsteller, Jr. _____ Typed or printed name _____ (972) 233-0939 _____ Telephone number _____ June 26, 2006 _____ Date </div> </div> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p> | | | | | | | | | |
| <input type="checkbox"/> *Total of _____ forms are submitted. | | | | | | | | | |

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

In re Application of:

Michael J. Iosue

Serial No.: 10/765,538

Confirmation No.: 1649

Filed: January 27, 2004

For: NIGHT VISION DEVICE AND
METHOD

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Group Art Unit: 2879

Examiner: Dalei Dong

Reasons for Review with Form PTO/SB/33

Applicant submits the following reasons justifying a review requested with the accompanying Form PTO/SB/33.

Applicant respectfully requests review of the instant application on the basis of originally submitted Claims 16 through 19. Claim 16 is the main claim and the remaining claims are directly or indirectly dependent upon that claim.

This is an appeal from the Final Rejection of April 10, 2006. The Examiner's main ground of rejection is that claims 16 and 18 are unpatentable over U.S. Patent No. 5,493,111 by Wheeler et al. (*Wheeler*) under 35 U.S.C. §102(b). Additionally, the Examiner has further rejected the claims under 35 U.S.C. §103 in view of the same *Wheeler* reference in view of U.S. Patent No. 5,338,927 by de Groot et al. (*de Groot*).

None of the grounds for rejecting the claims can be supported either factually or legally for reasons that will be set forth below.

35 U.S.C. § 102(b) Grounds for Rejection

The *Wheeler* patent shows an image intensifier tube or photomultiplier having a “brazing flange member 52” that effects the sealing engagement between the window member 16 and the base member 50. *Wheeler* goes on to further describe the seal 52 as follows:

“The window **16** is sealed into flange **52** with indium or similar seal material **52'**. Flange member **52** is brazed onto the housing member **50** at step portion **72**.” (Col. 7, line 65 to col. 8, line 1)


Independent Claim 16 recites the following elements, the most pertinent to this discussion being presented in bold type for the convenience of the Examiners:


A method of making an image intensifier tube, said method including the steps of:

- providing an annular tube body;
- providing a microchannel plate disposed within said tube body;
- providing an electrical contact structure between said tube body and said microchannel plate;
- providing a yieldably deformable and axially-variable sealing structure** sealingly uniting the tube body with a window member, said window member carrying a photocathode; and
- yielding said axially-variable sealing structure while maintaining a selected fine-dimension spacing between the photocathode and microchannel plate.

Since such **yieldably deformable and axially-variable sealing structure** of the Applicant's invention as claimed is nowhere disclosed nor suggested by *Wheeler*, Applicant suggests that the claimed structure of the present invention is neither identical to nor disclosed by the *Wheeler* device. Therefore, *Wheeler* cannot anticipate the present claimed invention.

The common definition of the "deformable" term is as shown by the following definition from Dictionary.com. (**Note** the definition particularly for "physics" situations.)


de-form  **Pronunciation Key** (dī.fōrm)
v. **de-formed, de-form-ing, de-forms**
v. *tr.*

- 
1. To spoil the natural form of; misshape: a *body that had been deformed by disease*.
 2. To spoil the beauty or appearance of; disfigure.
 3. *Physics*. To alter the shape of by pressure or stress.
 4. *Geology*. To change the original state or size of a rock mass, especially by folding or faulting.

v. *intr.*

To become deformed. See Synonyms at distort.

Thus the common definition of the "deformable" term clearly contrasts with US Patent 5,493,111 to Wheeler *et al.* (*Wheeler*) that describes the seal 52 as a "brazed flange member," Col. 6, lines 30-31, or that "[f]lange member 52 is brazed onto the housing member 50," Col. 7, line 65 - Col. 8, line 1. Unlike deformation that is defined as being by stress or force as it particularly pertains to the physics of situations, to braze is defined as using "solder with a high melting point," as shown by the following definition for braze from Dictionary.com.


brazed  **Pronunciation Key** (brāz)
tr.v. **brazed, braz-ing, braz-es**

- 1 To make of or decorate with brass.
- 2 To make hard like brass.

[Middle English *brazen* from Old English *brazian* from *braz* *brass*.]

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brazed  **Pronunciation Key** (brāz)
tr.v. **brazed, braz-ing, braz-es**



To solder (two pieces of metal) together using a hard solder with a high melting point

[Probably from French *brazier* from Old French *to burn* from *braz* *hot coal* of Germanic origin. See *brazier* in Indo-European Roots.]

brazers

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brazed



v. solder together by using hard solder with a high melting point

In the Final Rejection, pages 2 and 3, the Examiner concluded that *Wheeler* in Figures 1-4 disclosed a method for "providing a yieldably deformable and axially-variable sealing structure (52') sealingly uniting the tube body (12 and 50) with a window member (16)." However, *Wheeler* teaches only a structure in which "window 16 is sealed into flange 52 with indium or similar seal material 52'" with "[f]lange member 52 [being] brazed onto the housing member 50." [Emphasis added] Col. 7, line 66 to Col. 8, line 1. Therefore, *Wheeler* cannot anticipate the present claimed invention since *Wheeler* does not disclose or suggest in common, ordinary use of the terms a yieldably deformable and axially-variable sealing structure.

Moreover, the allegedly prior art devices lack the functional characteristics of the claimed structure of the independent claims in the present application. The cited device requires high heat and a hard solder component that tend to create unintended consequences particularly when working with fine tolerances.

Even if the *Wheeler* patent incidentally showed a similar arrangement of parts, if that arrangement is neither claimed nor designed to perform the function of the present invention, *Wheeler* cannot act as an anticipation.

35 U.S.C. § 103 Grounds for Rejection

The Examiner has also rejected the Claims under 35 U.S.C. § 103(a) as being unpatentable over *Wheeler* in view of *de Groot*.

de Groot teaches an image intensifier tube having "glass beads" as shims 25 between the primary screen 19 and the input face 8.

"In the exemplary embodiment shown in FIG. 2, where the shims 25 are constituted by beads, these beads may be fixedly joined to the input face 8 of the slab 7 of microchannels by bonding." *de Groot*, Col. 5, lines 63-66.

Applicant's invention is directed toward an axially variable yielding sealing structure and maintaining a selected fine-dimension spacing between the photocathode and the microchannel plate. Nowhere does *de Groot* teach that any of seals or spacers of the image intensifier components are deformable. Rather, *de Groot* teaches that the primary screen **19** is the component that is “deformable.” *de Groot*, Col. 6, lines 26-31.

The rejection should be removed because there is no teaching or disclosure **in the prior art of record** that would have suggested to the artisan the obviousness of providing a yieldably deformable and axially-variable sealing structure.

In order to establish a prima facie case of obviousness, the prior art teachings must be sufficient to suggest making the substitution or modification necessary to make the claimed invention to one of ordinary skill in the art, In re Lulu, 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1984), in the absence of applicant's own disclosure.

Dependent Claims 17-19 that depend from independent Claim 16 are also not made obvious by *Wheeler* or *de Groot* because they include the limitations of Claim 16 and add additional elements that further distinguish the art. Therefore, Applicants respectfully request that Claims 16-19 be allowed.

Conclusion

Applicant consequently submits that the pending claims are patentably distinct from *Wheeler*. In light of the reasons set forth above, Applicant respectfully requests review and allowance of Claims 16-19.